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10/521,719

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Tobias Helbig

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

ABYANEH, ALI S

ART UNIT

PAPER NUMBER

2437

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/521,719 | Applicant(s) HELBIG ET AL. | |
| | Examiner ALI S. ABYANEH | Art Unit 2437 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4 and 6-26 are presented for examination.
2. Claims 1-19 are amended.
3. Claims 20-26 are newly added.
4. Claim 5 is cancelled.
5. Examiner withdraws the objection to the discloser.
6. Examiner withdraws the objection of claims 1-19 due to the correction by the applicant.

Response to Arguments

7. Applicant's amendments/arguments filed on 12-02-2008 have been fully considered but are moot in view of the new ground(s) of rejection.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

Art Unit: 2437

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1-4 and 6-26 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-15 of copending Application No. 10/522,289. Claims 1-15 of Application 10/522,289 contain every element of claims 1-4 and 6-26 of the instant application and as such anticipate claims 1-4 and 6-26 of the instant application. Although the conflicting claims are not identical, they are not patentably distinct from each other.

"A later patent claim is not patentably distinct from an earlier patent claim if the 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2437

(a) patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4, 6-10, 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann (EP 1024626 A1) in view of Marino et al. (US Patent No. 6,167,137).

Regarding claim 1, 18 and 19

Herman teaches a security system for a network comprising a portable unit with a key unit for making a key record available and being provided for short-range information transmission of the key record and at least one receiving unit in at least one apparatus of the network, comprising a receiver for receiving the key record and an evaluation component for storing, processing and/or passing on the key record or a part of the key record to a second component (paragraph [0044]-[0046]).

Herman does not explicitly teach wherein the key record is erasable from the at least one receiving unit **in response to a user interaction**. However, in an analogous art, Marino teaches the key record is erasable from the at least one receiving unit in response to a user interaction (column 8, lines 45-60).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hermann to include wherein the key record is erasable from the at least one receiving unit in response to a user

Art Unit: 2437

interaction. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to provide higher degree of security and prevent unauthorized access to secured premises (column 3, lines 19-21).

Regarding claim 2-4

Hermann furthermore teaches the security system, wherein the unit comprises at least one triggering unit for triggering a short-range transmission of information, particularly a short-range information transmission of the key record; upon a user's approach to the receiving unit, a detector unit in the unit triggers the short-range information transmission of the key record; and wherein the key unit comprises a key generator (14) for generating a sequence of guest key records (paragraph [0019]-[0020]).

Regarding claim 6 and 7

Hermann furthermore teaches wherein the key record consists of a bit sequence and wherein the bit sequence comprises characterizing bits used for distinguishing and characterizing key records (paragraph [0020]-[0021]).

Regarding claim 8-10

Hermann furthermore teaches the unit is a part of an apparatus, particularly a remote control unit (paragraph [0044]); the key record is supplied

Art Unit: 2437

during or before a network configuration, particularly an automatic network configuration, of an apparatus; and the apparatus is provided for authentication, encryption and/or decryption, by means of a key in the key record of useful data transmitted between the apparatuses of the network (paragraph [0020]-[0021]).

Regarding claim 12-15

Hermann furthermore teaches wherein the key unit comprises a reading device for reading a mobile data memory, particularly a chip card having a decoding key record stored thereon; the key unit comprises a writing device for writing data into the mobile data memory; the unit and the apparatus are adapted to transmit a confirmation by the apparatus to the unit, indicating the consequence of performing an instruction transmitted from the unit to the apparatus; the confirmation comprises an identification code for the apparatus (paragraph [0047]-[0048]).

Regarding claim 16

Hermann furthermore teaches the key unit is adapted to store useful data in the mobile data memory, allowing the management of key records read from the data memory and installed on apparatuses, and block the transmission of a key record from the mobile data memory to an apparatus in case said useful data comply with a predetermined criterion (paragraph [0044]).

Regarding claim 17

Hermann furthermore teaches the unit comprises a triggering unit whose activation causes the apparatus to erase a key record (paragraph [0020]).

Regarding claim 20-23

Marino furthermore teaches wherein the user interaction includes pressing an erase button on the portable unit; wherein the portable unit includes an erase button for erasing the key record from the at least one receiving unit; wherein the key record is replaceable in the at least one receiving unit with a new key by first re-transmitting the key record by the portable unit and then transmitting a new key; wherein the key record is replaceable in the at least one receiving unit with a new key by supplying the new key a predetermined number of times and at predetermined time intervals (column 8, lines 52-60).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann (EP 1024626 A1) in view of Marino et al. (US Patent No. 6,167,137) further in view of Coppersmith et al. (EP 0843425).

Regarding claim 11

Hermann and Marino teach all limitation of the claim as applied to claim 1 above. Hermann and Marino do not explicitly teach a memory for **storing** a

Art Unit: 2437

worldwide unambiguous key record. However, in an analogous art, Coppersmith teaches storing a worldwide unambiguous key record (column 20, line 23).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hermann and Marino to include storing a worldwide unambiguous key record. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to retrieve and use the stored key later.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann (EP 1024626 A1) in view of Marino et al. (US Patent No. 6,167,137) further in view of Howard, JR. et al. (US Publication No. 2001/0026619).

Regarding claim 24

Hermann and Marino teach all limitation of the claim as applied to claim 1 above. Hermann and Marino do not explicitly teach wherein the key record is configured to expire or is automatically erased in the at least one receiving unit and is retransmitted by the portable unit within predetermined intervals. However, in an analogous art, Howard teaches the key record is configured to expire or is automatically erased in the at least one receiving unit and is retransmitted by the portable unit within predetermined intervals (paragraph [0022]).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hermann and Marino to include wherein the key record is configured to expire or is automatically erased in the at least one receiving unit and is retransmitted by the portable unit within predetermined intervals. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to provide an automated key management system for managing key material in cryptographic assets (paragraph [0002]).

14. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann (EP 1024626 A1) in view of Marino et al. (US Patent No. 6,167,137) further in view of Dent et al. (US Patent No. 5,812,955).

Regarding claim 25 and 26

Hermann and Marino teach all limitation of the claim as applied to claim 1 above. Hermann and Marino do not explicitly teach wherein the key unit comprises a key generator for generating a guest key, the guest key being automatically erased after a fixed period of time; and the guest key being erasable in response to providing the key record to the at least one receiving unit. However, in an analogous art, Dent teaches wherein the key unit comprises a key generator for generating a guest key (column 3, lines 59-61), the guest key being automatically erased after a fixed period of time; and the guest key being

Art Unit: 2437

erasable in response to providing the key record to the at least one receiving unit (column 20, lines 29).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hermann and Marino to include wherein the key unit comprises a key generator for generating a guest key, the guest key being automatically erased after a fixed period of time; and the guest key being erasable in response to providing the key record to the at least one receiving unit. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to provide systems which do not compromise security of a system which they interact (column 2, lines 26-29)

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2437

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abyaneh whose telephone number is (571) 272-7961. The examiner can normally be reached on Monday-Friday from (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on **(571) 272-3865**. The fax phone numbers for the organization where this application or proceeding is assigned as (571) 273-8300 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A. S. A./

Examiner, Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437